

REMARKS

Applicants would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicants' Information Disclosure Statements by return of the forms PTO-1449, and for the acknowledgment of Applicants' claim for priority and receipt of the certified copies of the priority documents in the Official Action.

Upon entry of the present paper, claim 1 will have been amended, with claims 1-8 remaining pending before the Examiner. In view of the above, Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

Turning to the merits of the action, the Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,067,027 to YAMAZAKI, noting that while this reference "lacks specific reference to the dioptric power difference between the eye and the ocular lens system and the observation optical system being cancelled, [t]he specification of the current application states, on page 32, that the dioptric power difference can be cancelled by adjusting the distance between the ocular lens system and the aperture plane" and concludes that it would have been obvious to have the ocular lens system of YAMAZAKI positioned so as to cancel the dioptric power difference.

Applicants submit that the Examiner has not set forth a proper rejection under 35 U.S.C. § 103(a), and that this rejection is thus inappropriate in that the Examiner's above assertion is without support. Specifically, merely changing the position of the ocular lens system does not render YAMAZAKI capable of canceling a dioptric power difference. It appears that the Examiner has, based upon Applicants' disclosure, picked various individual features of the reference and has

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combined them with what the Examiner has (improperly) found to be within the level of one skilled in the art, in the manner taught by Applicants' disclosure. This hindsight reconstruction is inappropriate under 35 U.S.C. § 103. Applicants thus request that the Examiner cite at least one reference in support of this assertion, if the Examiner chooses to maintain this rejection.

Applicants further respectfully traverse the above rejection and submit that Examiner's rejection is inappropriate. Applicants submit that YAMAZAKI, as well as the other references of record, are markedly different from the present claimed invention. Specifically, with respect to independent claim 1, YAMAZAKI fails to teach or suggest at least that the second focusing mechanism is constructed in such a manner that the photographing optical system is positioned at an object side, in relation to a theoretical position determined when the photographing optical system focuses on an object, when said observation optical system focuses on the object, wherein a measured dioptric power difference is cancelled, as claimed in claim 1. This feature is described, *inter alia*, in Fig. 13 and in page 29, line 23 – page 30, line 2 and in page 37, lines 4-20 of Applicants' specification.

To the contrary, while YAMAZAKI (as the Examiner correctly noted) has ocular lenses which can be positioned at different locations along the optical axis, YAMAZAKI has does not have the ability to position a photographic optical system at an object side, in relation to a theoretical position determined when the photographing optical system focuses on an object, when said observation optical system focuses on the object, to cancel a measured dioptric power difference.

With respect to the Examiner's rejection of dependent claims 2-8, since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent

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claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Thus, Applicants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicants note that this amendment is being made to advance prosecution of the application to allowance, and with respect to the features claimed in independent claim 1 argued as deficient in the prior art, should not be considered as surrendering equivalents of the territory between the claim prior to the present amendment and the amended claim. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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Respectfully submitted,
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A handwritten signature in black ink that reads "Will. Boshnick". The signature is written in a cursive, slightly slanted style. Below the signature is a horizontal dashed line.

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